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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,144	07/02/2002	Kuolih Tsai	81350PROPCTUS	6328
23685	7590	03/29/2004	EXAMINER	
KRIEGSMAN & KRIEGSMAN			CHANG, VICTOR S	
665 FRANKLIN STREET			ART UNIT	PAPER NUMBER
FRAMINGHAM, MA 01702			1771	

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

ST

Office Action Summary	Application No. 10/031,144	Applicant(s) TSAI ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 and 76-79 is/are pending in the application.
4a) Of the above claim(s) 26-37, 57-63 and 76-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 38-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/7/02</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I and Species A (claims 1-25 and 38-56), and cancellation of claims 64-75 in Paper Response filed 2/23/2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Specification

2. First paragraph of the application should include a cross-reference to related application. In particular, it is noted that this application is a 371 of PCT/US00/17703, which claims benefit of 60/142,728. Appropriate correction is requested.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 and 38-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a release coating of crosslinked acid functionalised α -olefin containing copolymer, does not reasonably provide enablement for a release coating having a total surface energy of about 25 to 35 mN/m, of which

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about 0.1 to 4 mN/m is polar surface energy. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

More particularly, it is noted that the independent claims 1 and 38 recite “a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy” (as a genus having certain properties), whereas the Specification only discloses a release coating of crosslinked acid functionalised α -olefin containing copolymer (Specification, page 17, first paragraph), the disclosure is considered insufficient to represent “a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy” as a genus per se. As such, the absence of the critical elements of suitable polymer compositions in claims 1 and 38 renders the instantly claimed invention unduly broad and in excess of its provided disclosure. It should be noted that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice ... by functional characteristics coupled with a known or disclosed correlation between function and structure ... sufficient to show the applicant was in possession of the claimed genus. If a representative number of adequately described species are not disclosed for a genus, the claim to that genus must be rejected as lacking adequate written description under 35 U.S.C. 112, first paragraph. See MPEP § 2163.IIA3(a)ii.

Finally, the preamble “A transfer label” of claims 38-49 also appears unduly broad and in excess provided enablement of the Specification, because clearly only a

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label suitable for transferring under a heated process (see Examples 1-5) has been is disclosed. Cancellation is suggested.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-25 and 38-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1 and 38, the structural relations of the layers, are vague and indefinite. The Examiner would like to suggest combining the structural limitations of claim 3 and 4 into claim 1, and claim 40 and 41 into claim 38, respectively.

In claims 15 and 50, line 3 of each claim, the term (B) appears to be a typo. For the purpose of this Office action, it is presumed to be (b).

Additionally, for claims 1 and 38, the recitation "a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy" is vague and indefinite, because it gives no notice as to what constitutes infringement upon the instantly claimed invention. It should be noted that claims merely setting forth physical characteristics desired in article, and not setting forth specific structure and/or compositions which would meet such characteristics, either in the claim or Specification, are invalid as vague, indefinite, and functional, since it recites compounds by what it is desired that they do rather than what they are. As such, it is unclear as to what is the scope of the invention of which Applicant intends to claim. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making coated polymer film substrate:

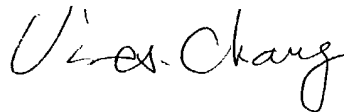
US 6114021 to Pankratz et al. is directed to a primed polymer films having improved adhesion characteristics. The film base wherein polymers forming a polymeric film surface and selected from polyesters, polyolefins and polyamides are coated with an adhesion enhancing primer coating containing (a) a functionalized α -olefin containing copolymer; and (b) a crosslinking agent selected from the group consisting of amino formaldehyde resins, polyvalent metal salts, isocyanates, blocked isocyanates, epoxy resins and polyfunctional aziridines; and wherein the adhesion enhancing primer coating is applied to the polymeric film surface and reacted, at elevated temperatures with newly generated polymeric film surfaces formed during uniaxial or biaxial stretching and heat setting (Abstract). It is noted that Pankratz's invention teaches exactly the same coated film substrate of the instant invention, whereas it provides a releasing property for instantly claimed heat transfer label during transfer process, instead of providing an improved adhesion in Pankratz's application.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor S Chang
Examiner
Art Unit 1771

3/19/2004